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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,993	10/05/2001	Danny W. Bilyeu	4944US (01-03-105)	4144
7590	08/09/2006		EXAMINER	
MARSHALL GERSTEIN & BORUN			HARPER, TRAMAR YONG	
6300 SEARS TOWER			ART UNIT	PAPER NUMBER
233 SOUTH WACKER DRIVE				
CHICAGO, IL 60606-6402			3714	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/971,993	BILYEU ET AL.	
	Examiner Tramar Harper	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 29-54 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 29-54 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/25/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Amendment***

Examiner acknowledges receipt of amendment on 03/09/06. The arguments set forth in the response are addressed herein below. Claims 29-54 are pending, Claims 29, 35, 41-43, & 49 have been amended, and Claims 1-28 have been canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 29-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird et al. (US 6,981,635) in view of Bennett (US 6,251,013).**

**Claim 29, 31-35, 41-43, & 46-49:** Hughs-Baird discloses a slot gaming machine where a player initiates spinning video reels, by placing a wager. If the reels display at least two symbols on the same horizontal row, the game displays interaction between the symbols and a payout is awarded to the player. As such the game allows the player to select one or more of the interacting symbols via a touch screen (Col. 1:63-Col. 2:8; Col. 5:55-65). Referring to Figs. 5a-d, a player selects interacting symbol (80), and as a result the two symbols to the left of (80) transforms and an award is displayed in Fig. 5d (Col. 7:55-65). Also, the gaming device comprises of a display device, a wager acceptor device, a user input device (touch screen), and a processor and memory device for controlling all gaming functions of the gaming device including symbol

interactions (Col. 4:14:62, Col. 5:10-15). Hughs-Baird teaches all of the above limitations but excludes a payout based on the transformed symbol and at least one other symbol other than the interacting symbol and the transformed symbol. Bennett discloses a slot machine game where a sprite (interactive symbol) swaps symbols (transforms the symbols) and if any winning combinations occur a payout is paid to the player (Col. 5:25-33). The winning combinations include the transformed symbol and at least one other symbol other than the interactive symbol and transformed symbol (Figs. 6a-c – Note: the swap symbols are on different pay-lines). Hughs-Baird discloses that gaming devices with a variety of symbols are well known (Col. 1:44-45). Hughs-Baird also discloses that providing a gaming device with a gaming scheme which provides award for obtaining symbols that interact is exciting, pleasurable, and enjoyable to players, considering that one spin or one touch can bring instant failure or success (Col. 7:30-35). Bennett discloses that gaming manufacturers are keen to devise games that are popular to improve sales. Bennett further discloses that providing complexity in numbering and combinations of indicia that could result in a win would convince a player that there is greater chance of winning and keeps their interest in the game (Col. 1:37-40; Col. 1:47-52). It would have been obvious to one of ordinary skill at the time of the invention to modify the interactive symbol gaming device, as taught by Hughs-Baird, with a payout based on all symbols (transformed and non-interacting/transformed symbols) on a particular pay-line, as taught by Bennett, to increase a player's interest and excitement and as a result sales will increase.

**Claims 30 & 44:** Hughs-Baird discloses displaying at least one interactive symbol arranged in at least one of the plurality of reels (Figs. 5a-d).

**Claim 31 & 45:** Bennett discloses displaying at least one interactive symbol not arranged in the plurality of reels (Figs. 6a-c).

**Claim 36 & 50:** Hughs-Baird discloses the gaming device has a program that automatically begins a secondary or bonus round when a player has achieved a qualifying condition or triggering event in the primary game (Col. 5:10-15).

**Claims 37 & 51:** It is notoriously well known in the art to have triggering events to a feature game that comprise of amount of wager, maximum wager, etc.

**Claims 38-39 & 52-53:** Hughs-Baird discloses that upon player selection of symbol (80) symbols (78), (82), and (80) interact/transform with each other. As a result, player is awarded a prize (Col. 7:55-65; Figs. 5a-d).

**Claim 54:** Hughs-Baird discloses that the controller (processor and memory) includes program code for controlling the gaming device so that it plays a particular game in accordance with applicable game scheme and any applicable pay tables (includes pay award based on interacting and transforming symbols) (Col. 4:30-33).

#### ***Response to Arguments***

Applicant's arguments, see (Pgs. 9-11:Part A) filed 03/09/06, with respect to Claims 29-54 have been fully considered and are persuasive. The Double Patenting and Inventorship rejections of Claims 29-54 have been withdrawn.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US Patent of Rothschild (6,786,818), Baerlocher (6,561,900), Rose (6,589,114), Kaminkow (6,731,313), the US PreGrant Pub.'s of Rogers (2003/0064802), and Visocnik (2004/0048646) all teach similar structured gaming devices with interactive symbols. The US PreGrant Publication of Gauselmann (2004/0092299) discloses player selectable payouts. The US Patent of Acres (6,319,125) teaches triggering events based on wager related data.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH

08/04/06

JOHN M. HOTALING, II  
PRIMARY EXAMINER

